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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,238

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Tilak M. Shah

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW

PO BOX 14329

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

FIDEI, DAVID

ART UNIT

PAPER NUMBER

3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/633,238

Applicant(s)

SHAH, TILAK M.

Examiner

David T. Fidei

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 39-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-29 and 31-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/11/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Specification***

1. The amendment filed August 11, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Page 8, second full paragraph.

“Furthermore, relative to a central longitudinal axis extending through the closed distal end 14 and the open proximal end 20, the open proximal end 20 has a cross-sectional area (in a direction perpendicular to the central axis) at least as large as the average cross-sectional area of the centrifuge tube 10.”

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 31-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nothing in the original specification describes the centrifuge tube of body with an average cross-sectional area in a direction perpendicular to the central axis, and the open proximal end has a cross-sectional area at least as large as the average cross-sectional area.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 22-24, 26-29, 31-33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobler (Patent no. 5,255,808) in view of Hurtig (Des. 267,076). A tubular member 2 is disclosed in figure 2 having a closed distal end at 3 and an open proximal end at 5, with integral hinge elements 6 at opposing sides thereof for facilitating flattening of the tube. The difference between the claimed subject matter and the body is recited to have a substantially uniform diameter along the open proximal end or a diameter at least as large as the average cross sectional area.

The particular shape of the body proximal end, uniform, non-uniform or a cross section at least as large as the average cross section fails to solve any stated problem or is for any particular purpose. Hurtig figure 3 is suggestive of a receptacle shape with an open end that is substantially similar as the remainder of the body. It would have been obvious to one of ordinary skill in the art to modify the bottle of Tobler by constructing an open end substantially uniform in diameter as taught by Hurtig for the reason that such a change would have merely been a matter of design choice.

As to claim 26, Tobler discloses a tube comprising folding lines 6 on an exterior surface of the tube, that also constitute a ridge structure.

As to claims 27 and 36, process by which the tube is formed, i.e., by a molding technique selected from the group consisting of extrusion blow molding and rotational molding, is not seen as imparting a distinguishing characteristic over the product per se.

As to claims 28 and 37, it would have been a matter of ordinary skill to construct the generally cylindrical form about 3 to 8 inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, Gardner v. TED Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. 2144.04 (IV).

As to claims 29 and 38, polypropylene is disclosed in col. 6, line 16 of Tobler.

7. Claims 25 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobler as applied above, and further in view of Amand (U.S. Patent no. 3,537,498). Tobler (Patent no. 5,255,808) discloses the claimed subject matter except for a concave depression on an exterior surface facing one another. Amand teaches a concave depression on an exterior surface facing one another as shown in figure 1 by sections 2, 3. It would have been obvious to one of ordinary skill in the art to modify the containers of the prior art by constructing such a feature. The motivation for this modification is to permit grasping thereof.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 22-38 have been considered but are moot in view of the new ground(s) of rejection.

While it is acknowledged the drawings form part of the disclosure it is not agreed one skilled in the art would have gleaned the open proximal end 20 is to have a cross sectional area at least as large as the average cross sectional area of the centrifuge tube 10. In fact the last paragraph of the specification points out on page 12 that the invention provided is for illustrative purposes and not limited by the features of the specific embodiments. If the drawings were


descriptive of the newly added subject matter then it appears such amendments to the disclosure would not be necessary. However, such is not the case as further enumeration is required.

This action is Non-Final.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
February 1, 2007